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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,028	07/19/2000	Louis H. Sciupac	DTC 00-03	2216
3897	7590	08/09/2005	EXAMINER	
SCHNECK & SCHNECK P.O. BOX 2-E SAN JOSE, CA 95109-0005			LE, THIEN MINH	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/619,028

Applicant(s)

SCIUPAC ET AL.

Examiner

Thien M. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-31 and 33-43 is/are pending in the application.
- 4a) Of the above claim(s) 29-31,33 and 36-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-28,34 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The amendment filed on 1/6/2005 and the response to the restriction/election requirement filed on 5/9/2005 have been entered. Claims 1-2, 4-28 and 34-35 remain for examination. Claims 3 and 32 have been canceled. Claims 29-31, 33, and 36-43 have been withdrawn from considerations.

### ***Specification***

The abstract of the disclosure is objected to because it contains more than 150 words. Correction is respectfully required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2, 4-10 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Hohle et al. (Hohle et al. – 6,101,477; herein after referred to as Hohle; cited previously) in view of Teper et al. (Teper et al. – 5,815,665; herein after referred to as Teper; newly cited).

Regarding claims 1 and 21-23, Hohle discloses a in a system of reading data encoded on a storage medium 100, a method of business interaction between a broker 10 and an agency 12 comprising: providing a user with a secure storage medium smadcard 100, recording personal transaction information (e.g. EF 504, 510-512, 518, 526) and biometric data EF 522, 714, etc. on the medium; verifying the user identification with the biometric data using cardholder ID application 406., reading selected portions of the information (see column 5, lines 30-63, and elsewhere), transmitting selected information to said broker 10 (see column 5, line 64 to column 6, line 17 and column 26, line 36 through column 27, line 67) and the broker using said selected information to broker a transaction between said agency 12 and said user.

The claim, as amended, differs in calling for the transaction to be conducted without revealing selected information to the agency.

However, this claimed limitation is not new. Reference to Teper is cited as evidence showing the conventionality of the method of not revealing confidential investor/customer data to service provider. Specifically, Teper discloses a “method in

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which Service Providers host their own content as directly-accessible sites (referred to herein as "SP sites") on a distributed network such as the Internet, while relying on a centralized Online Broker site (which implements an Online Brokering Service) to handle user-authentication and billing matters. **The system advantageously allows users to purchase online services from the SP sites directly, without having to transmit payment information and other personal information over the distributed network, and without having to reveal such information to the Service Providers from which the online services are purchased. In a preferred embodiment the SP sites are in the form of Web sites on the Internet, and the online services available on the Web sites are accessed by the user using a single account (e.g., username and/or password) established between the user and the Online Broker.** " (see the summary of the invention; col. 2, lines 50-68; figures 1-6)

It would have been obvious to incorporate the method of maintaining confidential data at the broker's database in the manner as taught by Teper in the system as taught by Hohle. It further would have been obvious to use the transaction card as taught by Hohle to purchase on-line products/services with one or more service providers via service brokers in the manner as taught by Teper.

The modification allows transactions to be conducted while avoiding the unnecessary transfer of confidential data over public networks such as the Internet, and thus improve the security aspects of Hohle's teachings. The modification also extends the use of Hohle's transaction card for purchasing online products/services using the online broker firms.

Regarding claim 2, Hohle discloses that the card could be “contactless cards, **optical cards**, minicards, “super-smart” cards, and the like” (see col. 28, lines 1-15), and thus would meet all limitations set forth in this claim.

Regarding claims 4-5, both systems as taught by Hohle and Teper, as have been discussed above, would include reader for reading confidential information stored; and thus would meet all limitations set forth in this claim. The step of inserting the card into a read is merely the typical operation functions of a card and its reader system.

Regarding claim 6, see the discussions regarding claim 1. Further, the step of conducting more than one transaction is subjective to the multiple usages of the card as taught by Hohle for conducting transactions.

Regarding claims 7-9, the system as taught by Hohle/Teper would include the agreements, the fee agreements, etc., between the broker and the agency (also referred to as service provider). Confirmation of a transaction status would be the typical function of a transaction system as taught by Hohle/Teper.

Regarding claim 10, see figure 1-6 of Teper.

Claims 11-20, 24-28 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Hohle et al. (Hohle et al. – 6,101,477; herein after referred to as Hohle; cited previously) in view of Teper et al. (Teper et al. – 5,815,665; herein after referred to as Teper; newly cited) and further in view of Ono et al. (Ono et al. – 5,909,023; herein after referred to as Ono; newly cited).

Regarding claim 11, see the discussions regarding claims 1-2, and 4-10.

The claim differs in calling for the method of tracking customer's purchasing behavior and providing online promotions.

However, this claimed limitation is not new. Reference to Ono is cited as an evidence showing the conventionality of the method and system for tailoring online promotions based on customer's purchasing needs and behaviors. Specifically, Ono discloses "an online shopping support method and system capable of supplying proper services matching user specific needs and conditions. Purchase history information of each good purchased by each user is stored at a service offering system. In response to an input of identification information from a service use system, the service offering system searches the purchase history information of the user corresponding to a user identifier and calculates a purchase interval of each good purchased by the user. The service offering system judges, for each good whose purchase interval was calculated, whether the time corresponding to the purchase interval has lapsed after the latest purchase day. The service offering system transmits information of the good whose time corresponding to the purchase interval has lapsed to the service use system via a communication network and displaying the information at the service use system." (see the abstract)

It would have been obvious to further incorporate the method of tailoring online promotions to specific customer's needs and purchase behaviors in the system as taught by Hohle/Teper. The modification provides more customer services to the customers, benefiting the service provide with increase in sales, and benefiting the customers with discount products and/or services.

Regarding claim 12, see the discussions regarding claim 11. Further, it is noted that the combined system of Hohle/Teper/Ono would allow the customers to view promotions from the online broker's websites in the manner as suggested by Teper (see figures 1-6 and their descriptions from the Teper reference).

Regarding claim 13, see the discussions above.

Regarding claims 14-19, see the discussion above. Further, Teper is discussing the method of providing each user an account and a password so that confidential data will not be transfer over the public networks such as the Internet when not necessary. As to the claimed service provider's website, the broker's websites, the middle-ware agent, etc., the limitations are either have been discussed above and/or are considered as inherent in the combined online transactions as taught by Hohle/Teper/Ono, as has been discussed above.

Regarding claim 20, Hohle discloses the method of using the kiosk for conducting transaction. The examiner is of the view that the information stored in a computer as taught by the combined system by Hohle/Teper/Ono can be downloaded into the kiosk for conducting transaction via the transaction card. In a sense, the use can open an online account using the a computer; storing such account information/transaction information on the card; and the using the card for conducting tractions at the kiosk in the manners as suggested by Hohle.

Regarding claims 24-28 and 34-35, see the discussions above regarding the combined teachings of Hohle/Teper/Ono. The examiner is of the view the limitations such as digital signature, destruction of transmitted data, transferring user's information



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such as credit card number to other agency, etc., are included in the combined system as taught by Hohle/Teper/Ono. The use of digital signature is considered inherent for system involving purchases of securities, funds, etc., as taught by both Hohle and Teper. The step of destroy transmitted data after it has been logged or recorded is considered inherent in system involving credit card number and confidential customer information, especially when transactions are conducted online in the manner as suggested by Teper and Ono. The step of sharing customer's information among trusted agencies, service providers, online-brokers are considered inherent in view of the multiple brokers/service providers environment as shown in figure 1 of Teper.

### **Remarks**

Applicant's arguments filed on 1/6/2005 have been considered but are moot in view of the new grounds of rejection.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Le, Thien Minh', written in a cursive style.

**Le, Thien Minh**  
**Primary Examiner**  
**Art Unit 2876**  
**July 27, 2005**